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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL J. SHOFF, VALERIE L. BRONSON, JOSEPH H.
MATTHEWS, III, and FRANK A. LAWLER

Appeal 2008-1086
Application 09/349,638
Technology Center 2600

Decided: July 8, 2008

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and KARL D.
EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 56-57 and 61-67. No other claims are pending. (Br. 5)
We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to an interactive entertainment system for presenting supplemental interactive content together with continuous video programs. (Spec. 1).

Claim 56 is representative of the claims on appeal:

56. A viewer computing unit for receiving and displaying continuous video content programs, comprising:

a memory;

a processor programmed to determine whether the video content programs are interactive;

a tuner to tune to channels carrying the video content programs; and

an Internet browser stored in the memory, the Internet browser being dynamically loadable for execution on the processor when the tuner is tuned to a channel carrying a video content program that is interactive.

The Examiner relies on the following prior art references to show unpatentability:

Youman	US 5,629,733	May 13, 1997
Freeman	US 5,861,881	Jan. 19, 1999
Steele	US 5,884,056	Mar. 16, 1999

1. Claims 56, 61, and 63-67 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the collective teachings of Freeman and Steele.
2. Claims 57 and 62 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the collective teachings of Freeman, Steele, and Youman.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007)).

Freeman and Steele

Appellants' arguments regarding the claims rejected over the collective teachings of Freeman and Steele are directed to three separate groups as outlined below. (See Br. 15-28).

Claims 56, 61, 63 and 67

Appellants' arguments directed to claims 56, 61, 63, and 67 focus on claim 56; we select claim 56 as representative.¹ Appellants' mainly dispute the Examiner's finding (Ans. 3-5) that the collective teachings do not disclose or suggest a dynamically loadable Internet browser (Br. 15). The Examiner cited Freeman at column 19, lines 33-47, as teaching the display of interactive Internet content, and cited Steele at column 5, lines 10-21, as teaching an Internet Web browser, and determined that it would have been obvious to employ Steele's browser in Freeman's system in order to display and access Internet content and to allow Internet surfing (Ans. 16-17).

We concur with the Examiner's finding and determination. Appellants' response to the passage cited in Freeman upon which the Examiner relies focuses on a portion that discloses creating interactive programs. (Br. 18-19). Appellants conclude that Freeman "merely describes the creation of an interactive program . . . downloaded from an Internet site." (Br. 19). This argument lacks factual support. Freeman, as quoted by Appellants, states: "Furthermore, viewers can watch interactive programs from the Internet itself using the systems of the present invention." (Br. 19 (quoting Freeman, col. 19, ll. 34-52)).

Moreover, Steele teaches that "[p]art of the functionality of a browser is to provide image or video data" (col. 2, ll. 44-46). "In order to explore the WWW today, the user loads a special navigation program, called a 'Web browser' onto his computer." (Steele, col. 2, ll. 34-36). Since Freeman

¹ "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." 37 C.F.R. § 41.37(c) (1) (vii).

discloses watching interactive Web programs employing a processor (Fig. 1 – CPU 108) and Steele discloses that a browser provides video data for such watching, and for further exploring, Freeman’s systems implicitly include, or Freeman and Steele suggest, “an Internet browser dynamically loadable for execution on the processor” as set forth in the claim. Under *Leapfrog*, the combination of such familiar browser and Web video elements according to their known predictable uses of watching and surfing would have been obvious.

We also are not persuaded by Appellants’ related arguments that Freeman does not disclose a DLL or criteria for loading the web browser program. (Br. 19-20). These arguments are not commensurate in scope with the claim. Accordingly, we sustain the Examiner’s rejections of claims 56, 61, 63, and 67.

Claims 65 and 66

Appellants’ arguments are directed to claims 65 and 66 as a group; accordingly, we select claim 65 as representative (*see n. 1 supra*). Appellants maintain that the combination of Steele and Freeman does not suggest “displaying an icon to visually inform the viewer that the program is interactive compatible” as set forth in claim 65 (Br. 28). We disagree.

We first note that Appellants acknowledge that Freeman “merely discloses graphical displays, and does not disclose, teach or suggest an icon.” (Br. 27). We see no difference between such a graphical display and an icon as claimed, notwithstanding that Steele’s icon also functions as a hyperlink as Appellants note (Br. 27), since Freeman’s graphical displays or otherwise visual interactive commands may provide Internet interactive

content as the Examiner found (Ans. 9-10, citing Freeman, col. 7, ll. 10-12, col. 19, ll. 34-37, col. 13, l. 45+).²

Further, Appellants' arguments focus on the Freeman and Steele references individually. It is apparent, however, from the Examiner's line of reasoning in the Answer (Ans. 10), that the basis for the obviousness rejection is the combination of Freeman and Steele. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413,425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1096 (Fed. Cir. 1986). In other words, while Appellants contend that Freeman lacks a teaching of an icon (Br. 27), it is our view that Steele teaches such a feature (Steele, col. 2, ll. 30-36) for the reasons set forth by the Examiner. Similarly, while Appellants contend that Steele lacks a teaching of "visually informing the viewer that the program is interactive compatible" as claimed, Freeman, as noted above, provides this feature. (See Ans. 9-10, 20-21).

Appellants also assert that the combination does not disclose "launching an Internet browser" as set forth in claims 65 and 66. Again, this

² The term "icon," as claimed, does not functionally change Freeman's system over how it operates with respect to the disclosed graphics display overlay, and, thus, constitutes non-functional descriptive material. Non-functional descriptive material cannot render patentable an otherwise unpatentable product or process. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (Informative Opinion) (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006) ("Common situations involving non-functional descriptive material [include] . . . a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer) . . .").

bald assertion lacks any supporting argument and/or evidence refuting the Examiner's determination. We have already found this limitation, or a corresponding limitation, to be taught by the references as discussed *supra*.³ Accordingly, we sustain the Examiner's rejections of claims 65 and 66.

Claim 64

Appellants dispute the Examiner's determination that Freeman with Steele teaches "that a determination is made as to whether a program is interactive compatible by checking a channel separate from a channel carrying the video content program for [the] presence of supplement content" as called for in claim 64. (Br. 24). Appellants argue that Freeman uses trigger points in "ACTV codes [that] are part of the interactive program signal itself, and are not provided through a channel separate from the channel carrying the video content program." (Br 24). We disagree with the conclusion.

We do not see how the location of the trigger points governs the issue. Regardless of which video stream carries trigger points, Freeman's separate video channel carrying supplemental content checked by the microprocessor meets the claim, as further explained below. Therefore, we concur with the Examiner's determination that Freeman's two video channels meet the claim: "One data stream carries video information pertaining to the video signal the user is currently viewing. The second data stream carries the video signal *based on the user's previous and/or current interactive selections from the user interface*, as determined by the microprocessor [108]." (Ans. 18-19, citing Freeman (col. 9, ll. 8-25) (quotation original at

³ Appellants implicitly acknowledge that the browser limitation involves the same issue as claim 56 by referring to their discussion thereof (Br. 28).

Freeman, col. 9, ll. 19-25, emphasis added)). Appellants' explanation involving the trigger points does not address specifically why the Examiner's position is in error. We turn to Freeman.

Freeman discloses: "For example, in a live sports event, one *channel* could carry the standard video channel, with other *channels* carrying different camera angles and/or close-ups of particular players." (Col. 19, ll. 21-24) (emphasis added). Such different angles or close-ups constitute specific examples of supplemental video content on a separate channel. We determine that Freeman's system "checks" this separate channel in the manner claimed by *branching* to it:

An interactive presentation can comprise *branching* amongst full motion video, computer graphics and audio, with the *interactive elements either received over a transmission media* or stored locally, or both, all within the same show. . . . [T]he work station can *branch* among video segments from television broadcasts, local video servers . . . , still images and audio segments . . . hard disks . . . , and segments *obtained over networks such as the Internet.*" (Col. 4, ll. 32-41) (emphasis added) .

...
Multiple television channels may be received . . . [to provide] *seamless branching . . . among these television channels.*" (Col. 4, 61-65) (emphasis added).

...
The *interactive elements* may be broadcast . . . on *separate channels*, embedded in the existing video and/or transmitted before or during the program." (Col. 14, ll. 36-40) (emphasis added).

Generally, to perform such branching or checking, Freeman's CPU processes user supplied interactive commands/responses and determines

which video portions from which channels or other sources to insert into the viewed program and when to insert them using “trigger points.” (Freeman, col. 5, ll. 38-62; col. 9, ll. 21-24; col. 9, l. 67 to col. 10, l. 5; col. 12, ll. 32-65). In the example at column 9 cited by the Examiner, viewing a program on channel A instigates interactions and creates corresponding trigger points in, and seamless switching between, buffered video in channels A and C, at specific times dictated by the trigger points. (See generally our discussion *supra*, and Freeman, Fig. 7, col. 9, l. 8 to col. 10, l. 5).

According to Appellants’ disclosure, the mere existence of data in one channel indicates that the other viewed channel is interactive. (Spec. 17: 14-17). Further, Appellants’ two channels need not be related in content, as one channel might include “advertisements, merchandise or other memorabilia” (Spec. 9: 17), or “games, trivia information . . . and so on” (Spec. 5: 21-24).

Consequently, whether or not the claim requires the two channels to be related in content,⁴ and regardless of which channel carries trigger points,⁵ Freeman’s system branches to (checks) channel C, which Freeman teaches to include buffered interactive video from the Internet,⁶ and which is

⁴ Freeman also discloses downloading cooking recipes into cooking shows as another example of related content (in addition to the football show example described *supra*) (col. 19, ll. 12-18). Freeman’s broad disclosure as described *supra* suggests each of these related contents to be broadcast on different channels in the specific system cited by the Examiner.

⁵ In Freeman’s column 9 embodiment cited by the Examiner, both channels carry video that has been buffered and inserted with “programming codes” which the microprocessor uses as triggers to switch between the two channels (*see* col. 9, l. 25 to col. 10, l. 5).

⁶ Both of Freeman’s channels are rendered interactive – *see* col. 9, ll. 13-24. Buffering is discussed at n. 5 *supra*, while interactive Internet is discussed further next and at n. 7 *infra*.

separate from the channel A carrying video content, for the presence of supplemental content as dictated by the trigger points in channel A, and thereby “determines” that channel A is interactive.

Further, we also concur with the Examiner’s determination (Ans. 19, citing Freeman col. 6, ll. 10-23) that such trigger commands can occur in any path, such as local storage, or any video stream, which the Examiner broadly and reasonably construed as constituting checking a separate channel. Appellants fail to challenge this finding, so that we have no basis for finding error in it. Consequently, Freeman discloses, as another example meeting the limitation in dispute, branching between multiple interactive video streams on the Internet (i.e., the streams constitute “a channel carrying the video program content” and “interactive supplemental content”) as dictated by “interactive commands resident in the viewer’s computer” (i.e., processing the commands constitute “checking a channel separate from said channel”) (Freeman, col. 19, ll. 40-53).

Similarly, Appellants’ statement that the combination fails to teach “dynamically launching an Internet browser” as set forth in claim 64 (Br. 23) lacks the requisite explanation as to why the Examiner’s determination regarding this element is in error.⁷

⁷ We address this limitation *supra* in regards to claim 56. We also note that Freeman teaches branching to interactive Internet network(s) for separate video and/or related content (as quoted *supra* - col. 4, ll. 32-41, *see also* col. 19, ll. 40-52), which, we determine, in congruence with the Examiner (*see* Ans. 20) not only to constitute checking a separate channel in the manner as set forth in claim 64, but further, to suggest in combination with Steele’s browser, dynamically launching an Internet browser in order to view such video content, and/or to view related content.

Thus, on the whole, Freeman's system meets the claim as generally proposed by the Examiner. Accordingly, we sustain the Examiner's rejection of claim 64.

Freeman, Steele, and Youman

Appellants' arguments regarding the claims rejected over the collective teachings of Freeman, Steele, and Youman are directed to two separate groups as outlined below. (See Br. 28-35).

Claim 57

Appellants dispute the Examiner's determination that Youman discloses "the EPG associating a target specification to a target resource with a video content program" as recited in claim 57. (Br. 30). Appellants explain that for the claimed target: "The presence of a target specification within the data field indicates that the associated program is interactive and that the complementary content can be displayed in addition to the program itself." (Br. 30).

We do not see how this description differs from Youman's target specification. As the Examiner found, Youman's EPG displays and associates programs and target specifications designated by an interactive icon "i." (Ans. 15; Youman, Figs 19-20- *compare* Spec.: Fig. 3 – target specifications 58). "Any time this icon appears, the user can view additional programming information . . . related to the program, such as the names of cast members and the like, by depressing the "i" key 48 on the remote controller 40." (Youman, col. 18, ll. 2-7). Hence, Youman's "i" target specification is associated with a video content program such as "Perry Mason: Notorious Nun" (Fig. 20) and also, like Appellants' disclosed target specification, implicitly serves as "a pointer to a memory location" (Spec.

17:20-21) having such cast member names, or as a “hyperlink to a target resource” (*id.*: 22) such as an implied file or data list containing the cast member names – constituting target resources.

Therefore, while Appellants state Youman “merely describes [the] operation of an EPG to obtain additional information about a program,” (Br. 32), Appellants’ claimed invention as argued does no more, and only explicitly recites target specifications and resources which we find to be implicit in Youman’s interactive icons “i” which also point to data resources. Thus, Appellants have not persuaded us of error in the Examiner’s determination that Youman meets the disputed limitation. Accordingly, we sustain the Examiner’s rejection of claim 57.

Claim 62

For claim 62, Appellants restate their argument for claim 57 (Br. 33) and further list other claim limitations which do not constitute separate arguments for patentability. *See n. 1 supra*. Accordingly, for reasons we explained *supra* with regard to claim 57, we also sustain the Examiner’s rejection of claim 62.

DECISION

We have sustained the Examiner’s rejections with respect to all claims on appeal. Therefore, the Examiner’s decision rejecting claims 56-57 and 61-67 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2008-1086
Application 09/349,638

AFFIRMED

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